



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,334	08/04/2003	William S. Halliday	154-23110-USCP	6745
24923	7590	07/30/2007		
PAUL S MADAN MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA DRIVE, SUITE 700 HOUSTON, TX 77057-5662			EXAMINER ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER
			1712.	
			MAIL DATE	DELIVERY MODE
			07/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/634,334	Applicant(s) HALLIDAY ET AL.	
	Examiner Marc S. Zimmer	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-29,31-38 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 is/are allowed.
- 6) ☒ Claim(s) 20-29,31-37,40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant is advised at the outset that Examiner Marc Zimmer has inherited this case from Examiner Phil Tucker and will be carrying on its prosecution hereafter.

The rejection over GB 2131067 is hereby withdrawn in view of Applicant's removal of polyethylene latex from the list of suitable polymer latexes.

The rejection over *Stowe* is withdrawn not because of Applicant's efforts to have granted a petition awarding them the benefit of priority back to provisional application serial no. 60/211,162 but because *Stowe* did not, in the Examiner's estimation, deserve the benefit of priority back to the same insofar as the provisional application does not properly enable any embodiments of the polymer component other than polyvinylacetate and, thus did not qualify as prior art.

Claim Objections

Applicant is advised that should claim 22 be found allowable, claim 24 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Analysis

The method, as claimed, merely stipulates that a polymer latex of specific identity and water are brought into contact with the walls of a borehole. Accordingly, an

anticipatory reference need not mention the effect of inhibiting wall invasion because this result is inherently realized when a like composition is circulated into the borehole.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22, 24-29, and 31-37 are rejected under 35 U.S.C. 112, first paragraph, because the full scope of what is embraced by the term "precipitating agent" is unclear. The reason that this limitation is because (i) the term does not appear to enjoy widespread use in the prior art as it would pertain to aqueous drilling compositions- indeed, all of the disclosures surveyed by the Examiner in which this term was employed were all assigned to the same assignee as in the present case, and (ii) Applicant is not entirely committed to its exact role, see the description in paragraph 31 of the Specification and, hence, even the skilled artisan would have difficulty determining what compounds would serve in this capacity. Of course, this matter is rendered moot should Applicant simply add the limitations of claim 31 to claims 22, 24, and 27.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 1712

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-24, 26-28, 31, 33, 36, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Griffith et al, U.S. Patent Application Publication No. 2002/0022579. Griffith discloses an aqueous composition for sealing subterranean zones minimally comprising the materials outlined in the first several lines of paragraph 19, but also the surfactants mentioned in paragraph 46 and those that follow. Relevant to the present discussion, a favored embodiment of the rubber material on which the latex is based is styrene-butadiene (paragraph 24) and, more particularly, those having some sulfonate anion content (paragraph 26). The presence of sodium carbonate satisfies Applicant's requirement for a salt, and the organophilic clay bentonite (paragraph 59), an aluminum silicate, the requirement for a precipitating agent insofar.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-35 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffith et al, U.S. Patent Application Publication No. 2002/0022579. First, Griffith also mentions silicone rubber as a permutation of the rubber component from which a latex is formed. Although dimethylsiloxane rubber is not particularly disclosed, the Examiner takes notice of the fact that this species of the silicone rubber

genus is undoubtedly obvious as it is the most ubiquitous of the silicone polymers across a spectrum of applications for its wide commercial availability and economy. That is to say, where a specific property set is not desired, dimethylsiloxane is almost without exception the polymer of choice among silicone rubbers.

Concerning claims 33-35 and 40, the reference reports the quantities of these materials in terms of their weight fraction as a percentage of the total. Because this expression of quantity is not easily correlated with those recited in the claims, the Examiner cannot ascertain whether the amounts mentioned are consistent with those claimed. Nevertheless, it is the Examiner's position that one having ordinary skill is capable of optimizing their quantities, taking into account their known roles, as a matter of routine experimentation.

Claim 41 is awkward in its construct and it is not clear exactly how it should be interpreted. It would seem that this only serves to further limit the nature/compositional makeup of the borehole walls. In this connection, at least shale is frequently encountered in many drilling environments and, therefore, the claim is obvious.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

Art Unit: 1712

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory double patenting over claims 1-7 of copending Application No. 11/437,351. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Applicant states in their remarks that this rejection is overcome in view of their submission of a terminal disclaimer but the Examiner sees no evidence of one having been received.

Allowable Subject Matter

Claims 25, 29, and 32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

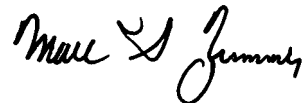
Claim 38 is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 25, 2007

A handwritten signature in black ink, appearing to read "Marc S. Zimmer".

**MARC S. ZIMMER
PRIMARY EXAMINER**